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PATENT

Attorney Docket No.: 033700 WC 004



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Bengt SANDBERG, *et al.*)
Appln. No.: 09/881,213) Group Art Unit : 1619
Filed: June 15, 2001) Examiner : Not yet assigned
For: Biotin Derivatives)

PETITION FOR RETROACTIVE LICENSE UNDER 37 CFR §5.25

Commissioner of Patents
Washington, D.C. 20231

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OFFICE OF PETITIONS

1. Petition

It is respectfully requested that this petition for license for foreign filing be granted retroactively under the provisions of 37 C.F.R. 5.25.

2. Material filed abroad without a license

The subject matter of the above-referenced patent application was filed abroad without first obtaining a foreign filing license. The foreign filings were inadvertent and made through error and without deceptive intention. The information disclosed abroad, Petitioners believe, did not contain any sensitive national security information.

Furthermore, diligence was exercised in seeking this retroactive license once Petitioners became aware of the proscribed foreign filing. A corresponding petition was filed on August 27, 2001 in copending application 09/750,280 having a filing date of December 29, 2000, and claiming priority from the present application. A corresponding

petition was likewise filed on October 9, 2001 in copending application 09/519,998 having a filing date of December 29, 2000, upon confirmation that that application was still to be pursued. The present petition is being filed upon confirmation that the present application is to be pursued, and upon being advised that the present application was related to the two applications just cited.

**3. Identification of inventor(s), title of invention and, if applicable,
details of corresponding U.S. applications**

Inventors : D. Scott Wilbur and Bengt E.B. Sandberg [and in the
present application, Rune Nilsson]

Title of Invention : Trifunctional Reagent for Conjugation to a Biomolecule

Assignees : Department of Radiation Oncology, University of
Washington,

and

Mitra Medical Technology AB.

U.S. Serial Nos. : 09/519,998 and 09/750,280

4. Foreign countries and dates of filing of material

for which retroactive license is requested (37 CFR 5.25(a)(1))

With respect to the material for which a retroactive license is requested, each foreign country in which the patent application material was filed and the date it was filed is as follows:

| <u>Foreign Country</u> | <u>Date</u> | <u>Filing No.</u> |
|------------------------|-----------------|-------------------|
| PCT/Sweden | July 7, 1998 | SE98/01345 |
| PCT/Sweden | July 7, 1999 | SE99/01241 |
| Norway/PCT Natl. Stage | January 3, 2001 | 2001 0021 |
| Japan /PCT Natl. Stage | January 9, 2001 | 2000-558395 |

Canada /PCT Natl. Stage
EPC /PCT Natl. Stage

January 5, 2001
February 1, 2001

2,336,739
99935251.1

5. Explanation with Verified Statement

a) the subject matter in question was not under a secrecy order at the time it was filed abroad, and it is not currently under a secrecy order;

b) the license is being diligently sought after discovery of the proscribed foreign filing without foreign filing license in place.

The facts in the case are as follows.

Drs. Wilbur and Sandberg, coinventors of the present patent application, and in the present application Rune Nilsson, jointly developed the concepts and studies which resulted in the subject matter of the present patent application prior to the time of filing the two PCT applications set forth above. As also noted above, the present patent application claims priority from the first PCT filing in Sweden, after which National Stage PCT Filings were made in Norway, Canada, Japan, the United States (Appln. Nos. 09/750,280 and 09/519,998) and the EPC. Dr. Wilbur is a U.S. citizen working at the University of Washington; Drs. Sandberg and Nilsson are citizens of Sweden working at Mitra Medical Technology AB.

In discussions with personnel at the University of Washington's Office of Technology Transfer about filing a patent application first outside the United States, Dr. Wilbur was advised that there would be no problem with first filing a patent application overseas. Indeed, the necessity of a U.S. citizen obtaining a foreign filing license before first filing a patent application overseas was not brought to Dr. Wilbur's attention until May 2001, being brought to his attention by the undersigned firm. Exhibit A is a letter

from Dr. Wilbur to Mr. Henriksson of AWAPATENT AB, Swedish patent agent in the matter, which sets forth in some detail the facts surrounding the foreign filings.

Accordingly, it may be seen that the oversight in not obtaining a license for foreign filing from the U.S. PTO was made through error without any deceptive intention. None of the subject matter involves any sensitive subject matter with respect to the national security of the United States of America. A similar petition was filed on August 27, 2001 in copending application 09/750,280 having a filing date of December 29, 2000; and on October 9, 2001 in copending application 09/519,998 having a filing date of December 29, 2000. The present petition is being filed upon confirmation that the present patent application is still to be pursued, and upon being advised that the present application is related to those earlier filed. The foreign filings disclosed in all three of the petitions are the same.

Counsel and Dr. Wilbur (through Mr. Henriksson) have corresponded on this matter since the first week of May 2001 and up until the date hereof, and this petition was prepared as soon as counsel received the necessary documentation identified as exhibit A and received also a further explanation of the foreign filings and the dates of such filings, and confirmation that the present application is still to be pursued, and that the present application is related to the two other U.S. applications..

The error in not obtaining a retroactive license was both inadvertent and without deceptive intent.

I declare, under penalty of the perjury laws of the United States, that all statements made herein of my own knowledge are true and that all statements made based on information and belief are believed to be true, and further that these statements

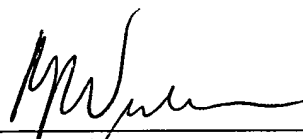
were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

6. Fee (37 CFR 1.17(h))

The fee for this Petition for Retroactive License is paid by the attached check for \$130.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

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November 8, 2001

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